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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,326	12/04/2000	Daniel Schreiber	21939-05596	8195

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EXAMINER

WU, ALLEN S

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,326

Applicant(s)

SCHREIBER ET AL.

Examiner

Allen S. Wu

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,8-11 . 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Israel on November 14, 1998. It is noted, however, that applicant has not filed a certified copy of the IL 127093 application as required by 35 U.S.C. 119(b).
2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Israel on December 30, 1998. It is noted, however, that applicant has not filed a certified copy of the IL 127869 application as required by 35 U.S.C. 119(b).
3. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/313,067 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

Specification

4. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Erickson, US Patent 5,765,152.

As per claim 1 and 4, Erickson discloses protecting files (copyrighted work, col 2 ln 61-67 and col 3 ln 1-17) distributed over a network (computer networks, col 3 ln 18-34), comprising the steps of: displaying a list of files (display of all DOCUMENT-packaged source works, col 22 ln 4-23); generating protection status information (auxiliary permissions, col 22 ln 4-23; dictate how the opened file may be used, col 16 ln 43-55; It is noted that Erickson does not explicitly teach protection status information. Using the permissions to dictate whether how the opened file can be used is essentially providing some type of protection for the file. A file having such auxiliary permissions will inherently have a protection status associated with the file) in response to selection by a user (user chooses, col 22 ln 4-12) of at least one of the files in the list of files (user chooses, col 22 ln 4-12; It is noted that Erickson does not explicitly state selecting at least one of the files in the list of files. Erickson discloses the user choosing to add auxiliary permission (col 22 ln 4-12). In order for a user to add permission, files must be selected in order for the system to know which files permissions are to be added. Therefore, the selection of at least one of the files in the list of files is to be inherent to the teachings of Erickson); and sending the protection status information to a server computer (auxiliary permission...licensing transaction, col 22 ln 4-23; licensing request signal... sent

to server, col 26 ln 18-49; It is noted that Erickson does not explicitly state sending of protection status information. However the licensing signal is generated and sent through the request for additional permissions used for the protection of the files. The auxiliary permissions are granted based on licensing transaction and protection status is updated. Therefore, protection status information is to be inherent to the teachings of Erickson.)

As per claim 2 and 5, Erickson further discloses displaying a list of files (display all DOCUMENT-packaged source works, col 21 ln 61-67 and col 22 ln 1-3) together with a corresponding protection status (minimum permissions...any auxiliary permissions, col 22 ln 4-23; It is noted that Erickson does not explicitly state protection status. However, the user can view the permissions and any auxiliary permissions (col 22 ln 13-23). These permissions dictate how the opened file may be used (col 16 ln 43-55) and thus show their protection status. Therefore protection status is to be inherent to the teachings of Erickson) for each file in the list of files (for each individual source work, col 22 ln 13-23), and wherein the method further comprises the step of modifying protection status of at least one of the files (upgrade permissions, col 22 ln 13-23), and wherein said sending step sends modified protection status information to a server computer auxiliary permission...licensing transaction, col 22 ln 4-23; licensing request signal...sent to server, col 26 ln 18-49; It is noted that Erickson does not explicitly state sending of protection status information. However the licensing signal is

generated and sent through the request for additional permissions used for the protection of the files. The auxiliary permissions are granted based on licensing transaction and protection status is updated. Therefore, protection status information is to be inherent to the teachings of Erickson.)

As per claims 3 and 6, Erickson further discloses recording the protection status information (registry information, col 23 ln 50-65 in a protection status database (database of registry information, col 23 ln 50-60; It is noted that Erickson does not explicitly teach a protection status database. The database of registry information contains permissions pertaining to each file. The protection status database of the applicant's invention used to store the protection status information of each file. Erickson teaches the permissions being used as protection status information as described above. The database of Erickson's invention holds registry information containing protection status information and is inherently a protection status database.)

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schneck et al US Patent 6,314,409 discloses a method of controlling access to protected files.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen S. Wu whose telephone number is 703-305-0708. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is N/A.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0900.

Allen S. Wu
Examiner
Art Unit 2131

ASW


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100